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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,342	03/11/2004	David Charles Lyons	77012-325539	6247
58506 7590 11/14/2007 FAEGRE & BENSON, LLP PATENT DOCKETING 90 SOUTH SEVENTH STREET 2200 WELLS FARGO CENTER MINNEAPOLIS, MN 55402			EXAMINER PAINTER, BRANON C	
			ART UNIT 3633	PAPER NUMBER
			NOTIFICATION DATE 11/14/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

e-OfficeActionHNI@faegre.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/799,342	LYONS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Branon C. Painter	3633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7-12 and 14-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 9-12, 14, 19, and 26-27 are objected to because of the following informalities:
  - a. Claims 9-12, 14: Claims depend from a cancelled claim. For the purpose of this examination, the examiner presumes they should depend from claim 1.
  - b. Claims 19, 26, 27: "first and second overlap members." For the purpose of this examination, the examiner presumes this should read "second and third overlap members."
  - c. Appropriate correction is required for all preceding objections.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "coupled respectively to the second ends of the first and second members and to the first ends of the first and second side members" renders the claim vague and indefinite, as it contradicts the limitations of amended claim 1. Amended claim 1 requires that the second and third overlap members are "configured to cover a spacing between the second end of the first/second side member and the floor." They therefore cannot be placed at the

corners of the surround as suggested by claim 14. This contradiction relates in a claim whose limitations are impossible to meet if also meeting the limitations of the preceding claims, and as such is precluded from further examination over the prior art.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

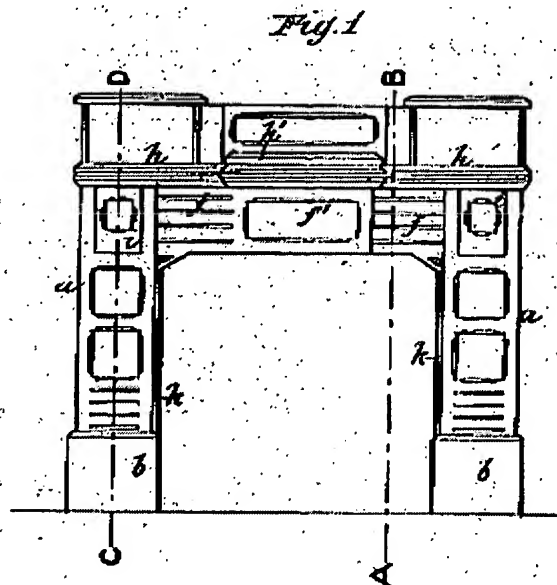
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10-12, 18-19, 26-27, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Gudgeon (U.S. Patent No. 254,868).
6. Regarding claim 1, Gudgeon discloses an adjustable mantel having all of the applicant's claimed structure, including:
- a. "a first member extending generally horizontally between a first and second end..." (left "frieze" f, Fig. 1).
  - b. "...a second member generally horizontally between a first and second end, the first and second members being oriented generally horizontally with the first ends facing each other..." (right "frieze" f, Fig. 1).
  - c. "...a distance between the second ends of the first and second members defining a width of the surround..." (Fig. 1).

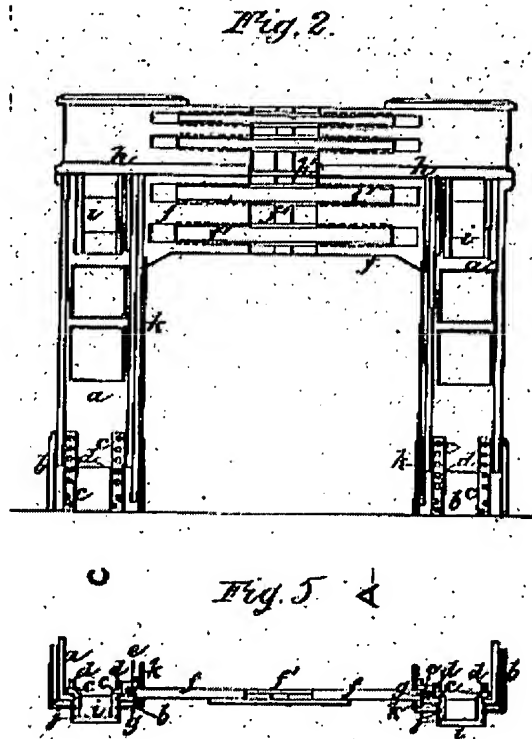
- d. "...wherein the first and second members are movable relative to each other to vary the width of the surround..." ("the frieze is formed in three parts, the outer two parts f, f sliding on the enter piece, f', and capable of being extended so as to be adjustable to suit different widths of fireplace openings or chimney pieces," page 2, lines 53-57).
- e. "...a first side member having a front face and a length extending generally vertically between a first end and a second end, the first end of the first side member being coupled to the second end of the first member..." (left "jamb" a, Fig. 1).
- f. "...a second side member having a front face and a length extending generally vertically between a first end and a second end, the first end of the second side member being coupled to the second end of the second member, the length of the first and second side members defining a portion of a height of the surround..." (right "jamb" a, Fig. 1).
- g. "...a first overlap member configured to cover the spacing between the first ends of the first and second members..." ("frieze" f', Fig. 1).
- h. "...a second overlap member having a top, an inner contoured surface that matches the front face of the first side member to provide a seamless appearance between the first side member and the second overlap member, and a bottom adapted to rest against a floor, where the second overlap member is configured to cover a spacing between the second end of the first side member and the floor..." (left "plinth" b, Fig. 1).

- i. "...a third overlap member having a top, an inner contoured surface that matches the front face of the second side member to provide a seamless appearance between the second side member and the third overlap member, and a bottom adapted to rest against a floor, where the third overlap member is configured to cover a spacing between the second end of the second side member and the floor..." (right "plinth" b, Fig. 1).
- j. "...wherein relative movement between the second and third overlap members and respective first and second side members adjusts a height of the surround." ("a, a are the jambs of the chimney-piece or covering, constructed, as shown, to slide and to be adjustable within the plinths b, b" page 2, lines 42-44).



Reproduced from U.S. Patent No. 254,868

7. Regarding claim 10, Gudgeon discloses a first overlap member with a front decorative surface and rear surface including a track structure for engaging a front decorative surface of the first and second members ("frieze" f, Figs. 2 and 5).



Reproduced from U.S. Patent No. 254,868

8. Regarding claim 11, Gudgeon discloses second and third overlap members with front decorative surfaces and rear surfaces including track structures to couple with respective side members ("plinths" b, Figs. 1, 2, and 5).
9. Regarding claim 12, Gudgeon discloses second and third overlap members coupled to first ends of respective side members ("plinths" b coupled to first ends of "jambs" a, Fig. 1).

10. Regarding claim 18, Gudgeon discloses the structure as recited in the response to claim 1.
11. Regarding claim 19, Gudgeon discloses first and second side members with first ends oriented generally downward, and second and third overlap members coupled to the first ends of respective side members (Fig. 1).
12. Regarding claims 26 and 27, the structure of the apparatus renders the claimed method steps inherent since the claimed method steps would inherently be performed when assembling the fireplace surround as disclosed by Gudgeon.
13. Regarding claim 33, Gudgeon further discloses a mantle shelf configured for mounting on top of the top member ("mantel-board" h, Fig. 1).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

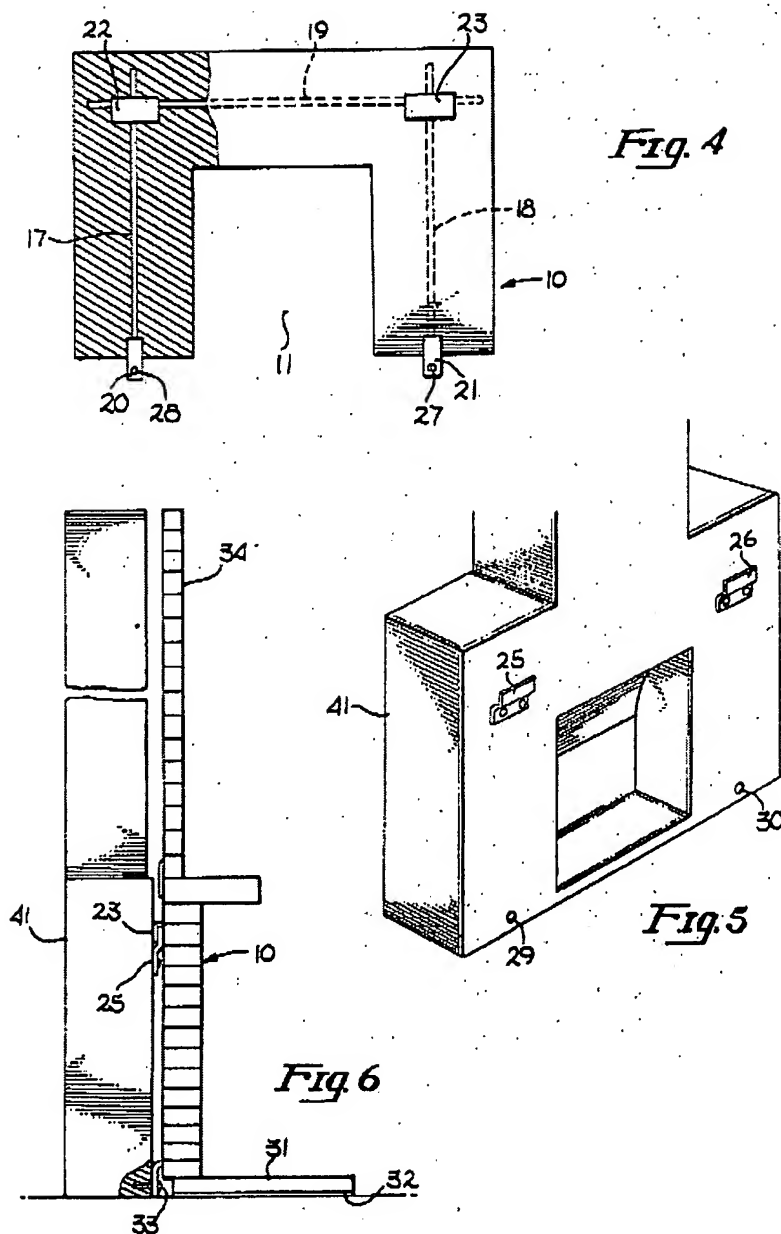


16. Claims 7-8, 15-17, 20-25, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudgeon (U.S. Patent No. 254,868) in view of Harris, Jr. (U.S. Patent No. 3,690,076).

17. Regarding claim 15:

- a. Gudgeon discloses an adjustable mantel as set forth above.
- b. Gudgeon does not expressly disclose first and second retaining or a wall mounting bracket.
- c. Harris, Jr. discloses first and second retaining members including a portion secured to the respective top member and a portion extending away from the top member ("hangers" 22 and 23, Figs. 4 and 6), and wall mounting brackets including a mounting portion extending along and secured to the surface of a fireplace or adjacent wall and an engagement portion extending outward and upward from the wall and engaging with the first and second retaining members ("wall brackets" 25 and 26, Figs. 5 and 6). It would be obvious to mount the retaining members on Gudgeon in positions similar to those of Harris, Jr., which would place one retaining bracket on each of the first and second top members of Gudgeon. The use of brackets and retaining members as taught by Harris, Jr. secures the fireplace surround to the wall or fireplace, which prevents injury caused by unstable, falling surrounds.

- d. Harris, Jr. does not expressly disclose that the mounting bracket is one elongated piece that engages with both retaining members; rather he teaches two separate mounting brackets, each of which engage with a single retaining member.
- e. The examiner further notes that it would have been an obvious matter of design choice to modify the two brackets of Harris, Jr. by making them one integral structure, since applicant has not disclosed that the single wall mounting bracket solves any stated problem or is for any particular purpose and it appears that the two wall mounting brackets of Harris, Jr. would perform equally well in securing the surround to the wall.
- f. Gudgeon and Harris, Jr. are analogous art because both are from the field of endeavor of fireplace surrounds.
- g. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to secure the mantel of Gudgeon to the wall using mounting brackets as taught by Harris, Jr., in order to protect occupants from unstable surrounds.



Reproduced from U.S. Patent No. 3,690,076

18. Regarding claims 7 and 8, Gudgeon in view of Harris, Jr. discloses the structure as recited in the response to claim 15.

19. Regarding claim 16, Gudgeon further discloses first and second top members, each including first ends that face one another, and where movement of the members adjusts the spacing ("friezes" f, Fig. 1).
20. Regarding claim 17, Gudgeon further discloses a first overlap member configured to cover the spacing between the first ends ("frieze" f', Fig. 1).
21. Regarding claims 20-25 and 28, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.
22. Regarding claims 29-32, Gudgeon in view of Harris, Jr. discloses the structure as recited in the response to claim 15.
23. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gudgeon (U.S. Patent No. 254,868) in view of Baxendale (G.B. Patent No. 852,169).
  - a. Gudgeon discloses an adjustable mantel as set forth above.
  - b. Gudgeon does not expressly disclose a first overlap member with a keystone shape.
  - c. Baxendale discloses a keystone-shaped first overlap member ("member" c, Fig. 1 – not shown). Adorning the first overlap member with a keystone shape as taught by Baxendale shows that ornamentation is well known in the art of fireplace surrounds.
  - d. Gudgeon and Baxendale are analogous art because both are from the field of endeavor of fireplace surrounds.

- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to embellish the first overlap member of Gudgeon with a keystone shape as taught by Baxendale, in order to make the surround more aesthetically pleasing.
- f. The examiner notes that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) {see MPEP 2144.04}.
- g. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.

### ***Response to Arguments***

24. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Branon C. Painter whose telephone number is (571) 270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Branon Painter  
10/29/2007



RICHARD E. CHILCOT, JR.  
SUPERVISORY PATENT EXAMINER